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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,085	03/23/2004	Laurence S. Blake	213789	3846

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EXAMINER	
FOX, CHARLES A	

ART UNIT	PAPER NUMBER
3652	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/807,085	BLAKE ET AL.	
	Examiner	Art Unit	
	Charles A. Fox	3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-23,25-27 and 33-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14,22,23,25-27,37,41-45,48-61,65-67 and 69* is/are rejected.

7)☒ Claim(s) *15-21,33-36,38-40,46,47,62-64 and 68* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20041022*
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Objections

Claim 66 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 65. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claim 66 is a duplicate of claim 65 with the added redundant phrase "and the plate picker towards the table". In the rejection of this claim below the redundant phrase is not considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 51 and 61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independent claims from which claims 51 and 61 depend have a system comprising a laser imaging device, wherein claims 51 and 61 have the device as further comprising a thermal imaging device. While the specification is enabling of the device as having either type of imaging system it is not enabling of the device as comprising both systems at the same time. It must have one or the other. An example of how to

claim these limitations can be found in claims 20,29 and 30 of U.S. Patent 5,738,014 to Rombult et al.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 69 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what the "generally horizontal vertical direction" is. Does this mean the device moves at 45° angle from the horizontal? Clarification is required. As this unclear direction makes up the basis of this dependent claim it has not been examined at this time as the full scope of the claim is indefinite at the time of examination.

Claims 23 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The surface is disclosed as being both positionable in the vertical and horizontal positions. It is not clear when the cassette is held by this surface. The claim language should be clarified to explicitly state when the cassette is held by the surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 53-60 and 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Platesetter 3244 Service Manual in view of Azzaroni. Regarding claims 53,55 and 58 Platesetter 3244 Service Manual (C80 on applicant IDS filed October22, 2004, herein Platesetter) teaches a device for loading and developing plates comprising:

a digital file of an image;

a plurality of plate support tables;

wherein each table corresponds to a particular plate stack;

an imaging engine with a drum and a laser for placing said digital image onto a plate;

an automated plate picker that removes a desired plate from any of the plate stacks as directed by an automatic controller;

wherein said plate picker is vertically movable to access any of the plate stacks on any of said tables. Platesetter does not teach a stationary picker with vertically movable tables. Azzaroni US 4,354,336 teaches a device for providing photosensitive plates to an imager comprising:

an elevator (83) with a plurality of tables (115);

a plate stack (109) located on each table;

a plate picker (80-81) for removing a plate from a selected plate stack for delivery to the imager;

wherein said elevator moves said tables vertically to place a preselected plate in an access position where the picker may pick up said plate;

wherein said plate picker moves in a horizontal direction with respect to the plate stack at the access level to transfer a plate to the imaging device. It would have been obvious to one of ordinary skill in the art, at the time of invention to modify the Platesetter to have a fixed picker with a movable elevator as taught by Azzaroni in order to increase the throughput of the device by allowing the next plate stack needed to move to the access position as the picker was moving a plate to the imager.

In regards to claim 54 Platesetter also teaches a front end controller for sending a signal to the system for identification of a next plate that will be called for.

Regarding claims 56 and 57 Platesetter further teaches a slip sheet detection and removal device for removal of slip sheets from the top of a stack of plates.

In regards to claims 59 and 60 Platesetter also teaches that the plates are photosensitive and that the interior of the device where the plate stacks are located is light tight.

In regards to claims 65,66 and 67 Platesetter teaches moving the plate picker towards a selected table in the magazine to pick a preselected plate.

Allowable Subject Matter

Claim 14 has allowable subject matter. The closest prior art of Platesetter and Azzaroni does not teach or suggest the limitation of placing the import support ((232) at the same level at the plate picker support (92) in the magazine. Once a timely filed terminal disclaimer is filed the rejections of claims 14,22,23 and 25-27 will be withdrawn.

Claims 15-21,33-36 and 38-40 are objected to as being dependent upon a rejected base claim, but would be allowable once the terminal disclaimer if filed and the rejection of claim 14 is withdrawn.

Claims 41-50 and 52 will be allowable once a timely filed terminal disclaimer is filed as discussed below. Independent claim 41 has the limitations dealing with the location of the access position where the plate picker is able to access the cassettes. The closest prior art of Platesetter and Azzaroni do not teach or suggest placing the access position between the upper and lower tables in the elevator section of their devices. Claims 42-50 and 52, which depend from claim 41, will also in condition for allowance at that time.

Claims 62-64 and 68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In regards to claim 62 the closest prior art of Platesetter and Azzaroni do not teach or suggest moving the elevator mechanism as the picker is delivering a plate to the imaging device.

In regards to claim 63 the closest prior art of Platesetter and Azzaroni do not teach or suggest moving both the table and the picker towards each other at the same time.

In regards to claims 64 and 68 the closest prior art of Platesetter and Azzaroni do not teach or suggest moving the table to engage the picker for removal of a plate.

Double Patenting

Claims 14,22,23 and 25-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3,4,6 and 7 of U.S. Patent No. 6,726,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '433 patent uses means plus function language in regards to the elevator mechanism and calls for a platform means in a load/unload position for the plates. In the instant application the claims have an elevator mechanism and a surface for loading plates into the device respectively for these same elements of the overall invention in the '433 patent. The dependent claims in both the '433 patent and the instant invention listed above all deal with the same limitations with minor variations in wording.

Claims (41&52), 42-45 and 48-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9,10,12-15 and 17-19 respectively of U.S. Patent No. 5,738,014. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only differences in the claims are in that the instant application calls for a laser to expose the plates once presented to the drum. The '014 patent only claims imaging the plate without providing an explicit means for doing so, however they disclose as being well known in the art the use of light to expose lithographic plates in the same device as the instant application. As such it would have been obvious to one of ordinary skill in the art, at the time of invention to use a laser as the exposure means as claimed in the instant application. The dependent claims in both the '014 patent and

the instant invention listed above all deal with the same limitations with minor variations in wording.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Response to Amendment

The amendment to the claims and specification filed on March 23, 2004 and October 22, 2004 have been entered into the record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Fox whose telephone number is 703-605-4294. The examiner can normally be reached between 7:00-5:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached at 703-308-3248. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CAF
CAF 1-11-05

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